

## **REMARKS**

### **INTRODUCTION**

The Office Action dated May 10, 2004 and the references cited therein have been carefully considered. In response, the applicant offers the following remarks and respectfully requests reconsideration and withdrawal of the rejections identified below.

### **OFFICE ACTION REJECTIONS**

Claim 1-4, 7-11, 13-16 and 18-24 are rejected under 35 U.S.C. Sec. 103(a) as being unpatentable over the Odyssey gaming machine by Silicon Gaming Inc. circa 1997 (the "Odyssey gaming machine") in view of Scott et al. (U.S. Des. Pat. No. 395,463), Hedrick et al. (U.S. Patent No. 6,135,884) and Carmean (U.S. Patent No. 4,517,654).

Claim 5 is rejected under 35 U.S.C. Sec. 103(a) as being unpatentable over the Odyssey gaming machine in view of Scott et al., Hedrick et al., Carmean and Pascal et al. (U.S. Patent No. 6,287,202).

Claim 6 is rejected under 35 U.S.C. Sec. 103(a) as being unpatentable over the Odyssey gaming machine in view of Scott et al., Hedrick et al., Carmean, Pascal et al. and Alcorn et al. (U.S. Patent No. 6,104,815).

Although the Office Action Summary indicates claims 1-24 are rejected, the Office Action does not provide any basis for the rejection of claims 12 and 17.

### **SYNOPSIS OF CITED REFERENCES**

Odyssey Gaming Machine Brochure, Silicon Gaming, Inc. Circa October 1997: A gaming machine capable of displaying a menu of a variety of available games that may be played. The games include slot games ("Win-O-Matic," "Dazzling Diamonds," "Fort Knox"), video poker ("Phantom Belle"), and video keno ("Star Spangled Keno," "Krazy Keno"). Each game includes video images displayed on a display screen.

Scott et al.: An ornamental design for an electronic gaming machine.

Hedrick et al.: A gaming machine having a main display and a secondary display for presenting video content including primary, secondary or tertiary information.

Carmean: A method and apparatus for simultaneously displaying portions of a stationary image and a moveable image on a video display. A stationary image plane is used for stationary images and a moveable image plane is used for moveable images.

Pascal et al.: A tournament gaming method and system, including a plurality of gaming terminals selectively interlinkable with a host terminal. Players of the terminals desiring to participate in group tournament play can be notified of the opportunity and provided with the choice to play.

Alcorn et al.: A method and apparatus for providing authenticated, secure, on-line communication between remote locations. A user terminal enables a player in one location to remotely communicate via a communications medium (e.g., the Internet) with a gaming host in another location.

### **ARGUMENTS FOR PATENTABILITY**

As an initial matter, the Office Action Summary indicates that claims 12 and 17 are rejected. However, as noted above, the detailed action of the Office Action does not provide any basis for the rejection of claims 12 and 17. As such, the applicant respectfully submits that the Office action fails to present a *prima facie* case for rejecting claims 12 and 17. Accordingly, claims 12 and 17 are patentably distinct from the cited references.

Turning to the rejections of claims 1-11, 13-16 and 18-24 under 35 U.S.C. Sec. 103(a), based on the cited references, the applicant respectfully submits that the Office Action fails to present a *prima facie* case of obviousness, inasmuch as the cited references fail to disclose or suggest all of the limitations recited in the independent claims, whether taken alone or in combination. As set forth in MPEP section 2143.03, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.

Further, the Office Action fails to present a *prima facie* case of obviousness, inasmuch as the neither the cited references nor the Office Action provides a sufficient motivation or suggestion to combine the references. As set forth in MPEP section 2143.01, to establish *prima facie* obviousness of a claimed invention, there must be some suggestion or motivation to combine.

## MISSING AND UNSUGGESTED ELEMENTS

All of the pending independent claims call for a plurality of first displayed items, such as playing cards (claims 1, 18 and 21), keno number spaces (claim 7) or a bingo card number spaces (claim 13), to change to displaying a display object inside the first displayed items wherein the portions of the display object create an identifiable object.

In contrast, the Odyssey gaming machine, as disclosed in the Odyssey Gaming Machine Brochure,<sup>1</sup> presents a menu on a video display screen displaying a variety of available games that may be played on the gaming machine. Video images for each of the games are displayed, including images for a vintage mechanical reel slot machine (“Win-O-Matic”), modern video slot machines (“Dazzling Diamonds” and “Fort Knox”), video poker (“Phantom Belle”), and video keno (“Star Spangled Keno” and “Krazy Keno”). The Odyssey gaming machine may display video images such as slot machine reels, playing cards and keno cards. However, the Odyssey gaming machine, as disclosed in the Odyssey Gaming Machine Brochure, does not progressively change the display inside game display elements to display a portion of a display object.

In particular, the images of the slot machine reels of the Odyssey gaming machine, as disclosed in the Odyssey Gaming Machine Brochure, do not progressively change to portions of a display object that create an identifiable image. While the slot machine reels appear to spin, the slot machine reels and the images thereon do not change to portions of a display image that collectively create an identifiable image. Likewise, the images of the playing cards (front or back) do not progressively change to portions of a display object that create an identifiable image. Although the playing cards change from displaying backs to displaying fronts as a virtual dealer deals the playing cards, the playing cards do not progressively change from card fronts or card backs to portions of a display object. Further, the images of keno numbers do not progressively change to portions of a display object that create an identifiable image. Although the keno number spaces may be marked to indicate selected numbers, the keno number spaces do not progressively change from keno numbers to a portion of a display object.

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<sup>1</sup> The Office Action refers to the Odyssey gaming machine by Silicon Gaming, Inc. circa 1997. Because the Notice of References Cited attached to the Office Action lists the “Odyssey Gaming Machine Brochure, Silicon Gaming, Inc. circa October 1997,” it is apparent that the Office Action relies upon this reference. As such, Applicant’s arguments are addressed to the Odyssey Gaming Machine Brochure.

Scott et al. teaches a design for a gaming machine. Scott et al. does not disclose any display images, much less disclose or suggest progressively changing a plurality of first displayed items to each display a portion of a display object inside the first displayed items, where the portions of the display object create an identifiable image.

Hedrick et al. teaches a secondary display in a gaming machine for providing video content, but does not teach or suggest progressively changing displayed items to portions of a display object that create an identifiable image. Although game displays may be generated on the primary display (spinning reels), the spinning reels and the images thereon do not change to portions of a display image that collectively create an identifiable image. Likewise, although displays may be generated on the secondary display (e.g., messages, animations, paytables, bonus games, etc.), the images do not change to portions of a display image that collectively create an identifiable image. For example, the secondary display may generate an image of a thermometer reading rising with each payout, an image of diamonds conveyed to a cart based on the slot results on the primary display, an image of cherries conveyed to a pie based on the slot results, images of the number seven moving across the display in correspondence with the slot results or an image of a spinning wheel. However, none of these images involve changing a plurality of first displayed items to each display a portion of a display object inside the first displayed items, where the portions of the display object create an identifiable image.

Carmean teaches a method and apparatus for simultaneously displaying portions of a stationary image and a moveable image on a video display. Carmean creates and displays a stationary image plane for stationary images and a moveable image plane for moveable images, such that, for example, an image of the number seven may move across a stationary image to give the impression of slot reel motion or rotation. However, the neither the moveable images nor the stationary images changing a plurality of first displayed items to each display a portion of a display object inside the first displayed items, where the portions of the display object create an identifiable image.

On the other hand, each of the independent claims specifies a manner in which an image is displayed that is distinct from the cited references. For instance, claim 1, and claims 2-6 by implication, recite a controller being programmed to display on the gaming display a plurality of playing cards where the playing cards change in a predetermined, non-random sequence at a predetermined speed from displaying one of card backs and card fronts to

displaying a portion of a display object inside the playing cards wherein the portions of the display object create an identifiable image. The Odyssey gaming machine, as disclosed in the Odyssey Gaming Machine Brochure, fails to disclose or suggest each of the following elements and related function of claims 1-6:

(i) the display of a plurality of playing cards where the playing cards change from displaying one of card backs and card fronts to displaying a portion of a display object inside the playing cards; and,

(ii) wherein the portions of the display object create an identifiable image.

Claim 7, and claims 8-12 by implication, also recite elements relating to the manner of displaying the portions of the display object inside the Keno number spaces. As a result, and for the reasons set forth hereinabove in connection with claims 1-6, the Odyssey gaming machine, as disclosed in the Odyssey Gaming Machine Brochure, fails to disclose or suggest each of the following elements and related functions (attracting players to the image and the specific game) of claims 7-12:

(i) the display of a plurality of keno number spaces in a keno game where the keno number spaces change in a predetermined, non-random sequence at a predetermined speed from displaying keno numbers to displaying a portion of a display object; and,

(ii) wherein the portions of the display object create an identifiable image.

Similarly, and for the reasons set forth hereinabove in connection with claims 1-6, the Odyssey gaming machine, as disclosed in the Odyssey Gaming Machine Brochure, also fails to disclose or suggest each of the following elements and related functions (attracting players to the image and the specific game) recited in claim 13, and claims 14-17 by implication:

(i) the display of a plurality of bingo number spaces in a bingo game where the bingo number spaces change in a predetermined, non-random sequence at a predetermined speed;

(ii) where the bingo number spaces change from displaying bingo numbers to displaying a portion of a display object; and,

(iii) wherein the portions of the display object create an identifiable image.

For the reasons set forth hereinabove in connection with claims 1-6, the Odyssey gaming machine, as disclosed in the Odyssey Gaming Machine Brochure, also fails to

disclose or suggest the following steps and related functions (attracting players to the image and the specific game) recited in claim 18, and by implication claims 19 and 20:

(i) changing a portion of the playing cards from displaying a portion of playing cards to displaying a portion of a display object wherein the portions of the display object create an identifiable display object; and,

(ii) changing in a predetermined, non-random sequence at a predetermined speed an additional portion of the playing cards from displaying a portion of playing cards to displaying a portion of a display object wherein the portions of the display object create an identifiable display object.

Lastly, and for the reasons set forth hereinabove in connection with claims 1-6, the Odyssey gaming machine, as disclosed in the Odyssey Gaming Machine Brochure, also fails to disclose or suggest each of the following elements and related functions (attracting players to the image and the specific game) recited in claim 21, and claims 22-24 by implication.

(i) a fourth memory portion physically configured with computer program instructions that would cause the gaming apparatus to change in a predetermined, non-random sequence at a predetermined speed from displaying the playing cards to displaying a portion of a display object inside the playing cards; and,

(ii) wherein the portions of the display object create an identifiable image.

Therefore, the claims are patentably distinct from the Odyssey gaming machine, as disclosed in the Odyssey Gaming Machine Brochure, Scott et al, Hedrick et al., Carmean, and any combination thereof.

Turning to the rejection of dependent claim 5 under 35 U.S.C. 103 as being unpatentable over the Odyssey gaming machine in view of Scott et al., Hedrick et al., Carmean and Pascal et al., it is respectfully submitted that Pascal et al. also fails to disclose or suggest the elements or steps and related functions (attracting players to the image and the specific game) identified hereinabove as missing from the teachings of the Odyssey gaming machine, Scott et al., Hedrick et al. and Carmean. Further, the Office Action does not provide any suggestion or motivation to combine the above references.

Turning to the rejection of dependent claim 6 under 35 U.S.C. 103 as being unpatentable over the Odyssey gaming machine in view of Scott et al., Hedrick et al., Carmean, Pascal et al. and Alcorn et al., it is respectfully submitted that Alcorn et al. also fails to disclose or suggest the elements or steps and related functions (attracting players to the image and the specific game) identified hereinabove as missing from the teachings of the Odyssey gaming machine, Scott et al., Hedrick et al., Carmean and Pascal et al.

### **LACK OF SUGGESTION OR MOTIVATION TO COMBINE**

The Office Action asserts that one of ordinary skill in the art with knowledge of the disclosures of the various references (i.e., hardware, software, cabinetry and results of graphical processing programming techniques) would find the claimed invention as obvious when viewing the references as a whole. However, the Office Action does not provide any objective reason for such a combination of references. As far as the applicant can discern, the Office Action does not provide any motivation or suggestion to combine the references. Simply because a series of references can be located that disclose the elements of a claim does not mean there is a motivation to combine the references. The mere fact that the references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). See also MPEP 2143.01. Further, the level of knowledge of one of ordinary skill in the art is insufficient to establish a *prima facie* case of obviousness, absent an objective reason to combine the teachings of the references. See *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also MPEP 2143.01. As such, merely given the knowledge of the references does not presuppose that one of ordinary skill in the art would be motivated to combine the references. Accordingly, as no motivation to combine the references has been described or can be discerned, a *prima facie* case for obviousness has not been made.

It is therefore respectfully submitted that claims 1-24 recite patentable subject matter over the Odyssey gaming machine as disclosed in the Odyssey Gaming Machine Brochure, either alone or with any combination of Scott et al., Hedrick et al., Carmean, Pascal et al. or Alcorn et al. Reconsideration is respectfully requested.

### CONCLUSION

Based on the foregoing amendments and remarks, the applicant submits that all pending claims are novel and non-obvious and are in condition for allowance. The references do not disclose all the elements of the claims and there is no motivation to combine the references. In the light of the foregoing, the prompt issuance of a notice of allowance is respectfully solicited. Should the Examiner have any questions, she is respectfully invited to telephone the undersigned.

Respectfully submitted,

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